

U.S. PTO Cust. No. 25280

Case No. 1996A

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Hans H. Kuhn et al.

Serial Number: 09/281,089

Filed: 03/30/99

For: TEXTILE SURFACE COATINGS OF IRON  
OXIDE AND ALUMINUM OXIDE

Group Art Unit: 1771

Examiner: J. Guarriello

FAX RECEIVED

OCT 31 2001

GROUP 1700

## PETITION FOR REOPENING OF PROSECUTION IN VIEW OF A NEW GROUND OF REJECTION WITHIN EXAMINER'S ANSWER IN RESPONSE TO APPELLANT'S BRIEF ON APPEAL

Box Petitions  
Commissioner of Patents  
Washington, DC 20231

Sir:

Applicants (Appellants) hereby petition the Commissioner under 37 C.F.R. §  
1.181(a)(2) to reopen prosecution within the above-referenced application. Upon filing  
their Brief on Appeal in this case, Appellants received an Examiner's Answer containing  
a new ground of rejection which therefore has not permitted them a fair opportunity to  
react thereto prior to decision by the Board of Appeals and Interferences. The facts of

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this situation are as follows:

### FACTS

- Appellants filed a Brief on Appeal on July 19, 2001, in response to the Final  
Rejection of all of the pending claims by the Primary Examiner. Such Final Rejections

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included some under 35 U.S.C. § 112 as well as an obviousness-based art rejection (under 35 U.S.C. § 103(a), namely based upon the teachings of U.S. Pat. No. 4,515,850 (hereinafter "Ishino et al.") in view of U.S. Pat. No. 4,911,957 (hereinafter "Watanabe et al.")).

2. Appellants then received an Examiner's Answer in reply to their Brief on October 2, 2001. Such Answer, although retaining most of the previous rejections under 35 U.S.C. § 112, did not retain the same art rejection of Ishino et al. in view of Watanabe et al. To the contrary, said Answer contained a brand new basis of rejection under the same statute, based upon the teachings of U.S. Pat. No. 4,911,957 (hereinafter "Oishi et al.") in view of Watanabe et al.

3. No explanation for the replacement of the previous Ishino et al. in view of Watanabe et al. rejection with the Oishi et al. in view of Watanabe et al. rejection was provided by the Primary Examiner.

### REASON FOR PETITION REQUEST

The request for such reopening of prosecution is made with sufficient cause and basis because of the specific requirements set forth within 37 C.F.R. § 1.193(a)(2), as well as M.P.E.P. § 1208.01. As such provisions within the rules state, such a new ground of rejection is improper and the Primary Examiner, again as required by rule, should have

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reopened prosecution upon introduction of such a new ground of rejection within the Examiner's Answer to Appellants' Brief on Appeal. As a result, Appellants respectfully request direction to the Primary Examiner to reopen prosecution in order to permit Appellants the opportunity to fairly respond to this new ground of rejection.

**PETITION FEES**

It is believed that a fee of \$130.00 is owing in relation to this Petition. The Commissioner is hereby authorized to deduct the requisite amount (\$130.00) as well as any other required amounts to place this petition in the proper condition for consideration by the Commissioner from our Deposit Account No. 04-0500.

Respectfully submitted,

October 31, 2001



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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to The Commissioner of Patents, Washington, DC 20231, on October 31, 2001, along with a postcard receipt.



William S. Parks, Attorney for Appellants